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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,835	03/25/2004	Martin R. Prince	100.004.6	7946

7590 09/28/2006

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EXAMINER

SMITH, RUTH S

ART UNIT	PAPER NUMBER
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3737

DATE MAILED: 09/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/809,835	PRINCE, MARTIN R.	
	Examiner	Art Unit	
	Ruth S. Smith	3737	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :6/28/04, 7/19/04, 3/21/05, 7/15/05.

Specification

The disclosure is objected to because of the following informalities: Applicant should update the status of the continuing data. Appropriate correction is required.

37 CFR 1.105 REQUIREMENT FOR INFORMATION

Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

There are numerous other co-pending applications and issued patents, which disclose and claim very similar and/or identical subject matter. In accordance with 37 CFR 1.105 and MPEP 704.11 (a) subsection G, applicant is respectfully requested to disclose all co-pending applications and related patents (please see the non-exhaustive list below of applications and issued patents that the USPTO believes may be related) and identify the specific claims of those applications and/or patents which may present double patenting issues with the instant application claims. This requirement is reasonably necessary to examination because, based on an initial review of the applications, there is a significant degree of overlap in claimed subject matter, thus requiring an analysis of commonality of claimed subject matter to determine patentability under 35 USC 101 double patenting and/or obvious type double patenting.

Should applicant believe that Double Patenting exists, then applicant is invited to file Terminal Disclaimers and/or amend the currently pending claims in the interest of expediting the prosecution of the current application.

Non-exhaustive list of possible related co-pending applications and patents:

11/003101
6,754,521
6,741,881
6,240,311
5,792,056
5,590,654
6,243,600
5,762,065
6,230,141

Art Unit: 3737

6,278,892

5,417,213

5,553,619

5,579,767

5,746,208

5,799,649

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 25-39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,741,881. Although the conflicting claims are not identical, they are not patentably distinct from each other because they involve an obvious broadening of the claimed limitations.

Claims 25-39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No. 6,240,311. Although the conflicting claims are not identical, they are not patentably distinct from each other because they involve an obvious broadening of the claimed limitations. Furthermore, the acquisition of data in the periphery of k-space after the initial data acquisition would have been obvious to one skilled in the art.

Claims 25-39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-34 of U.S. Patent No. 6,230,041. Although the conflicting claims are not identical, they are not patentably distinct from each other because the use of a monitoring unit would have been an obvious means for determining a change in the concentration of the contrast agent in the region of interest and thereafter initiating collection of image data. Furthermore, the acquisition of data in the periphery of k-space after the initial data acquisition would have been obvious to one skilled in the art.

Claims 25-39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 5,792,056. Although the conflicting claims are not identical, they are not patentably distinct from each other because the use of a monitoring unit would have been an obvious means for determining a change in the concentration of the contrast agent in the region of interest and thereafter initiating collection of image data. Furthermore, the acquisition of data in the periphery of k-space after the initial data acquisition would have been obvious to one skilled in the art.

Claims 25-39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-45 of U.S. Patent No. 5,590,654. Although the conflicting claims are not identical, they are not patentably distinct from each other because the use of a monitoring unit would have been an obvious means for determining a change in the concentration of the contrast agent in the region of interest and thereafter initiating collection of image data. Furthermore, the acquisition of data in the periphery of k-space after the initial data acquisition would have been obvious to one skilled in the art.

Claims 25-39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,278,892. Although the conflicting claims are not identical, they are not patentably

distinct from each other because they involve an obvious broadening of the claimed limitations. The use of a monitoring unit would have been an obvious means for detecting the contrast agent in the region of interest and thereafter initiating collection of image data. Furthermore, the acquisition of data in the periphery of k-space after the initial data acquisition would have been obvious to one skilled in the art.

Claims 25-39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-66 of U.S. Patent No. 5,417,213. Although the conflicting claims are not identical, they are not patentably distinct from each other because the use of a monitoring unit would have been an obvious means for detecting the contrast agent in the region of interest and thereafter initiating collection of image data. Furthermore, the acquisition of data in the periphery of k-space after the initial data acquisition would have been obvious to one skilled in the art.

Claims 25-39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-51 of U.S. Patent No. 5,553,619. Although the conflicting claims are not identical, they are not patentably distinct from each other because the use of a monitoring unit would have been an obvious means for detecting a change in the concentration of the contrast agent in the region of interest and thereafter initiating collection of image data. Furthermore, the acquisition of data in the periphery of k-space after the initial data acquisition would have been obvious to one skilled in the art.

Claims 25-39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 5,579,767. Although the conflicting claims are not identical, they are not patentably distinct from each other because the use of a monitoring unit would have been an obvious means for detecting a change in the concentration of the contrast agent in the region of interest and thereafter initiating collection of image data. Furthermore, the

acquisition of data in the periphery of k-space after the initial data acquisition would have been obvious to one skilled in the art.

Claims 25-39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of U.S. Patent No. 5,746,208. Although the conflicting claims are not identical, they are not patentably distinct from each other because the use of a monitoring unit would have been an obvious means for detecting a change in the concentration of the contrast agent in the region of interest and thereafter initiating collection of image data. Furthermore, the acquisition of data in the periphery of k-space after the initial data acquisition would have been obvious to one skilled in the art.

Claims 25-39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-44 of U.S. Patent No. 5,762,065. Although the conflicting claims are not identical, they are not patentably distinct from each other because the use of a monitoring unit would have been an obvious means for detecting a change in the concentration of the contrast agent in the region of interest and thereafter initiating collection of image data. Furthermore, the acquisition of data in the periphery of k-space after the initial data acquisition would have been obvious to one skilled in the art.

Claims 25-39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-54 of U.S. Patent No. 5,799,649. Although the conflicting claims are not identical, they are not patentably distinct from each other because the use of a monitoring unit would have been an obvious means for detecting a change in the concentration of the contrast agent in the region of interest and thereafter initiating collection of image data. Furthermore, the acquisition of data in the periphery of k-space after the initial data acquisition would have been obvious to one skilled in the art. The elimination of an element/step and its associated function would have been obvious.

Claims 25-39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,243,600. Although the conflicting claims are not identical, they are not patentably distinct from each other because the use of a monitoring unit would have been an obvious means for detecting a change in the concentration of the contrast agent in the region of interest and thereafter initiating collection of image data. Furthermore, the acquisition of data in the periphery of k-space after the initial data acquisition would have been obvious to one skilled in the art. The elimination of an element/step and its associated function would have been obvious.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth S. Smith whose telephone number is 571-272-4745. The examiner can normally be reached on M-F 7:30 AM-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 571-272-4956. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-4745.



FREDERICK R. SCHMIDT
DIRECTOR
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Ruth S. Smith
Primary Examiner
Art Unit 3737

RSS